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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,167	03/30/2001	Ellen Isaacs	2000-0027-CIP	9243

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EXAMINER

NGUYEN, TRONG NHAN P

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/823,167	ISAACS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jack P Nguyen	2152	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

This action is in response to Applicant's amendment filed on 11/17/04. Claims 21-26 have been added. Claims 1-26 are being examined.

### **Response to Arguments**

Applicant's arguments filed on 11/17/04 have been fully considered but are moot based on new grounds of rejection.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 10-17, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, 6,484,196 (hereafter Maurille) in view of Ng et al, 6,424,647 (Ng hereafter).**

As per claim 1, Maurille discloses a method for communicating via instant messages (abstract), the method comprising: receiving a message from a message sender designated for at least one message recipient, recipient (client) can receive different manifestations such as visuals (picture) or sounds (audio) from the sender/server (col. 6, lines 13-22; col. 7, lines 47-55; col. 11, lines 54-58; after sender sends an instant message to recipient, recipient receives message from sender; along with the message, recipient may receive a request from the server (message board) to

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download and display visuals or sounds that are associated with the message); determining when the message is received by the at least one message recipient, wherein a determination that the message is received is confirmed by a message acknowledgement (col. 6, lines 13-22; col. 11, lines 58-60; recipient acknowledges the message by clicking OK to respond to the sender); providing a status update for the message sender, the status update comprising a visual representation of the message having a first appearance when the message is pending and a second appearance when the message is received by the at least one message recipient (col. 13, lines 11-14, 18-22; message status (unread, read, responded to, etc.) are represented by their respective colors - e.g., a responded message is shown in purple color; each color represents different message status; the color changes as status of the message changes.) Maurille does not explicitly disclose the sound identifier is associated with the sender. However, it would have been obvious to one of ordinary skill in the art to modify the Maurille teachings to include in the manifestation a sound identifier of the sender along with the message so the recipient can recognize the sender in order to choose whether or not to respond to the message (see also Ng disclosure – col. 20, lines 53 – col. 21, lines 3; Ng discloses the sender sends a personalized audible (sound) signal to the recipient; upon detecting and recognizing the sender sound identifier, the receiver can choose to respond to the sender via instant messaging).

Claims 10 and 16 recite similar limitations as claim 1; therefore, they are rejected using similar rationale as claim 1.

As per claims 2-4, Maurille discloses assigning a unique sequential number to

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the message (Col. 11, Lines 19-20; each message is denoted by its message id (MsgID); MsgIDs are assigned in a sequential order – e.g., M001, M002, etc.); and updating a message listing and providing an acknowledgement to the message sender, wherein the message and acknowledgment are identified by the unique sequential numbers in the message listing (col. 11, lines 19-20; Col. 12, Lines 3-8; after the recipient has read and responded to the message (inherently an acknowledgement), the message listings of both the sender and recipient get updated with the new status of the message – i.e., message status changes from unread to read; messages (including acknowledgements) are assigned unique sequential numbers).

As per claims 5-7, Maurille discloses the visual representation is text from the message that alternates between a first color in the first appearance and a second color in the second appearance according to the respective status of the messages (Col. 13, L11-22; see also claim 1 rejection).

As per claim 8, Maurille discloses providing an acknowledgement to the message sender when the message is received by the at least one message recipient, the acknowledgement identifying the unique sequential number of the message (see claims 2-4 rejection); wherein the visual appearance of the status update before the acknowledgement is received is provided in a first configuration and in a second configuration once the acknowledgement is received (see claim 1 rejection).

As per claim 11, Maurille discloses the local message display provides a display of the message text in the pending and received configurations (see claim 1 rejection; message status changes as the messages is read and responded to).

As per claims 12-13, Maurille discloses determining when the instant message is received by the one or more message receivers and establishing a message listing for the message sender and the one or more message receivers (see claims 1 and 2-4 rejections).

As per claim 14, Maurille discloses the message listing prohibits duplication of the instant message on the one or more message receivers' devices (col. 12, lines 3-8; message listing (via message table) gets updated according to the status of the messages preventing message duplication).

As per claim 15, Maurille discloses the message listing is identified by a unique serial number (see claims 2-4 rejection).

As per claim 17, Maurille discloses the first appearance and the second appearance correspond respectively to a first coloration and a second coloration of the message (see claim 1 rejection).

As per claim 19, Maurille discloses removing a message from the message listing when the message is deemed received by the message acknowledgement (Col. 12, lines 3-8; once an acknowledgement has been received by the server, the server will forward the pending message to the receiver, thus removing the message from the pending status of the message listing).

As per claim 20, Maurille compiling a message listing of all pending messages wherein the message listing is updated when a message is acknowledged as received (see claims 2-4 rejection; message listing keeps tracks of all messages and their statuses in the messaging system).

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As per claims 21, 23, and 25, Maurille discloses request to play sound identifier (col. 7, lines 47-55; see also claim 1 rejection).

As per claims 22, 24, and 26, Maurille discloses sound identifier (col. 7, lines 47-55).

**Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille in views of Ng and Ogle et al, 6,654,790 (hereafter Ogle).**

As per claims 9 and 18, Maurille and Ng do not explicitly teach sending the message to the at least one message recipient to a plurality devices used by the message recipient and determining the location of one or more intended recipients of the pending messages. Ogle discloses a method of sending the message to a user who may use a plurality of devices as alternate means of receiving the message from plurality of locations (abstract, Col. 7, Lines 34-40; user may register for messages to be delivered to more than one recipient devices such as regular or cell phones; when the user is in the office, he may use a regular phone; thus when he's traveling, the messages may be delivered to his cell phone). Hence, it would have been obvious to one of ordinary skill in the art to deliver messages to the user by different means convenient to the user as also disclosed by Ogle [col. 7, lines 45-49].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (571) 272-3945. The examiner can normally be reached on M-F 8:30-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



Dung C. Dinh  
Primary Examiner